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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/629,272

07/29/2003

Peter Toop

GJE-7133

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03/17/2006

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EXAMINER

WILLSE, DAVID H

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/629,272 | Applicant(s) TOOP, PETER | |
| | Examiner Dave Willse | Art Unit 3738 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 2, "interior" should apparently be replaced by --anterior-- in order to be consistent with claim 3, line 2, and the original specification and drawings. The term "pointed" means "[h]aving an end coming to a point" (*Webster's II New Riverside University Dictionary*, 1984). The specification does not describe the annular rim as being "pointed" (amended claim 1, line 4), and it would be more accurate, in the examiner's view, to use language pertaining to a rim *cross-section* being pointed or to rim surfaces being tapered or converging.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4-8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lamielle et al., US 6,200,344 B1, which discloses an optic **34**, at least two haptics **38** compressible in the lens plane (column 4, lines 3-5, 36-40, and 58-62), and a pointed annular rim **36** (Figure 4) configured to contact the posterior capsular sac (column 5, lines 23-27). Regarding claims 4-6, in a first stage of compression, the proximal spring portions **44** are fully compressed such that "interior surfaces **62** may abut outer ends **58**" (column 4, lines 44-46); the abutment

enables the distal part **46** to be compressed (near spring portions **44**) in a second stage (column 4, lines 56-63).

Claims 1, 3, 7, and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Donn et al., US 5,074,875. Figures 2A and 2B illustrate pointed anterior and posterior rims around the optic, with the pointed posterior rim being configured to contact the posterior capsular sac (Figure 3B; column 5, lines 11-15). Because of their flexible, resilient nature (column 5, lines 10-15; column 10, lines 6-7), the haptics **13** can certainly be compressed in the plane of the lens.

Claims 1, 2, 7, and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ginsberg et al., US 4,562,600: figures; column 9, lines 4-8; column 13, lines 5-16 and 63-66; column 17, lines 22-30; etc.

The Applicant's remarks have been considered. The Applicant uses the expression "by definition" (page 6, line 10, of the reply received on January 9, 2006) but does not provide any definition (as prescribed in MPEP § 2111.01) of the expression "haptic can be compressed in the plane of the lens" (instant claim 1, line 3) in such a manner that haptics in patents such as US 4,562,600 and US 5,074,875 fall outside the scope of said definition. It is the Applicant's burden to precisely define the invention, and not the examiner's (*In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997)). The compression of haptics in all of the applied prior art certainly has components along radial directions (in a plane of the lens); moreover, "a plane" (instant claim 1, line 1) may be defined by distal portions of the haptics. The Applicant's other comments are adequately addressed in the above grounds of rejection, which were necessitated

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by the added claim limitations pertaining to the normal plane and the pointed annular rim.

Therefore:

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Dave Willse
Primary Examiner
Art Unit 3738